The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY MESSINA, SURENDRA KHAMBETE,
and GIRMA GEBRESELASSIE

Appeal No. 2006-1098
Application No. 09/990,115

ON BRIEF

KIMLIN, PAK, and TIMM, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-26 and 52-72. Claim 1 is illustrative:

1. A method of forming a sound attenuating laminate, comprising:

ascertaining acoustic properties of an article on which the sound attenuating laminate is to be placed to identify areas wherein additional sound attenuation characteristics are necessary;

forming a substrate in the shape of the article; and

applying polyurethane on the substrate, wherein the polyurethane is applied substantially only in the identified areas wherein enhanced sound attenuation characteristics are required.

The examiner relies upon the following references as evidence of obviousness:

De Winter	6,071,619	Jun. 6, 2000
Leenslag et al. (Leenslag)	6,335,379 B1	Jan. 1, 2002 (filed Nov. 23, 1998)

Appellants' claimed invention is directed to a method of forming a sound attenuating laminate for use in automobiles and the like. The method entails determining the acoustic properties of the article, such as the firewall or dashboard of an automobile, in order to identify areas of the article where sound attenuation is necessary. A substrate is then formed in the shape of the article and polyurethane is applied to the substrate in the areas that were identified as needing enhanced sound attenuation.

Appealed claims 1-26 and 52-72 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over De Winter in view of Leenslag.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we are in complete agreement with the examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning

of § 103 in view of the applied prior art. Accordingly, we will sustain the examiner's rejection for the reasons set forth in the Answer, which we incorporate herein, and we add the following primarily for emphasis.

De Winter, like appellants, discloses a method of applying polyurethane on a substrate, e.g., the interior trim of an automobile, only in identified areas of the substrate. As recognized by the examiner, De Winter does not disclose that the method of applying polyurethane on the interior of an automobile is for the purpose of attenuating sound. However, appellants do not dispute the examiner's factual determination that Leenslag discloses the application of polyurethane for providing sound insulation for automobiles. To wit, Leenslag discloses that "[t]he foams of the present invention may be used . . . as foams for sound insulation in automotive applications" (column 8, lines 35-39). Accordingly, based on the collective teachings of De Winter and Leenslag, we fully concur with the examiner that one of ordinary skill in the art would have found it obvious to apply polyurethane to the interior of an automobile for the purpose of effecting sound insulation. While Leenslag does not expressly teach the claimed steps of ascertaining the acoustic properties of an article and applying polyurethane only in the

identified areas of the article where enhanced sound attenuation is required, we agree with the examiner that "[s]ince Leenslag teaches employing the polyurethane foam as sound insulation, it implicitly teaches the step of first ascertaining the acoustic properties of an articles [sic, article] to identify areas where sound attenuation is necessary" (page 3 of Answer, first paragraph, last sentence). Indeed, insofar as Leenslag evidences that it was known in the art to employ polyurethane as sound insulation in automobiles, we are convinced that it would have been obvious for one of ordinary skill in the art to ascertain the specific locations in the automobile which require insulation from sound.

While appellants emphasize that neither of the applied references discloses the claimed step of ascertaining the areas needing insulation, it is not necessary for a finding of obviousness under § 103 that the prior art references specifically disclose a claimed feature. B.F. Goodrich Co. v. Aircraft Braking Systems Corp., 72 F.3d 1577, 1582, 37 USPQ2d, 1314, 1318 (Fed. Cir. 1996). It is well settled that the test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. In re

Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Appellants point out that the purpose of De Winter's application of polyurethane is "to apply different colored materials to a substrate aesthetically, not how to apply sound attenuating/absorbing material for acoustic purposes" (page 14 of Brief, first paragraph). Appellants submit, therefore, that modifying De Winter would likely destroy its intended purpose "since areas where sound attenuating/absorbing material may be required on a substrate may not necessarily be at locations where an aesthetically pleasing parting line can be achieved" (id.). However, we find sound reasoning in the examiner's response that combining the teachings of De Winter and Leenslag would not destroy the purpose of De Winter "but would instead enhance it because it would allow the material of De Winter to be both visually pleasing and sound absorbing" (page 5 of Answer, second paragraph). Moreover, we have no doubt that the collective teachings of De Winter and Leenslag would have made it obvious to apply polyurethane in selected areas of an automobile for either sound attenuation or aesthetics, or both, as desired/required.

As for separately argued claim 14 which requires applying the polyurethane into a recess of the substrate, we find no error in the examiner's finding that the figures of De Winter illustrate forming the polyurethane in recessed areas.

Concerning separately argued claim 15, appellants have not refuted the examiner's factual finding that "DeWinter teaches forming molded articles which comprise plural layers of polyurethane and then adding additional skin layers and other layers to form a finished article which can then be further processed to form a finished articles [sic, article] such as a dashboard. . See the example at col. 5, lines 52 - col. 6, line 64" (page 6 of Answer, first paragraph). Rather, appellants reference Figure 5 of their specification to support their argument that the examiner's claim interpretation is incorrect. However, the examiner properly notes that "the claims are not specific as to the particular item which is formed" (id.). It is by now axiomatic that features disclosed in the specification, but not recited in the claims, are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5, cert. denied, 474 U.S. 828 (1985).

As a final point, we note that appellants base no argument upon objective evidence of nonobviousness, such as unexpected

results, which would serve to rebut the inference of obviousness established by the applied prior art.

In conclusion, based on the foregoing and the reasons well-stated by the examiner, the examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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CHUNG K. PAK)
Administrative Patent Judge) BOARD OF PATENT
) APPEALS AND
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